

REMARKS

The present Amendment adds new claim 23 and leaves claims 1-22 unchanged. Therefore, the present application has pending claims 1-23.

In the Office Action the Examiner alleges that restriction under 35 USC §121 is required between alleged distinct inventions and between alleged patentably distinct species.

In response to the restriction requirement Applicants hereby elect Invention I, claims 1-6 and Species I identified as Embodiment 1 as illustrated in Figs. 1-6a, to which claims 1-6 are directed, with traverse for further prosecution on the merits.

With respect to the restriction requirement, the Examiner is hereby informed that the present Amendment adds new linking claim 23 which links the elected invention, Invention I, claims 1-6 and Species I identified as Embodiment 1, Figs. 1-6a to the non-elected invention, Invention II, claims 7-22 and Species 2-6, Embodiments 1-6, Figs. 6c, 8, 9, 10 and 11, respectively. As per the Response To Restriction Requirement filed on February 11, 2003, the contents of which are incorporated herein by reference, claim 1 of the elected invention is directed to a substantially planar transformer and claim 7 of the non-elected invention is directed to the very same substantially planar transformer wherein the substantially planar transformer is included in an integrated circuit. Claim 23 links the elected invention to the non-elected invention being that claim 23 is dependent from claim 1 and further limits claims 1 to a substantially planar transformer which is included in an integrated circuit. The Examiner's attention is directed to MPEP 809.03 wherein a description/definition of linking claims can be found.

As per MPEP 809 if an application is encountered having a linking claim linking an elected invention with a non-elected invention, then the "linking claim must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn". Further, according to MPEP 809 "any claim directed to the non-elected invention, previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability".

Therefore, according to MPEP 809 and 809.03 the forthcoming Office Action is required to examine the elected claims 1-6 along with the linking claim 23, and if the linking claim 23 be determined to be allowable, then the Examiner must rejoin non-elected claims 7-22 and perform an examination of claims 7-22 at such time.

With respect to the traversal, claim 1 from which depends claims 2-6, is directed to a substantially planar transformer and claim 7 from which depends claims 8-22, is directed to the very same substantially planar transformer wherein the substantially planar transformer is included in an integrated circuit. In the Office Action the Examiner alleges that restriction is required being that the alleged distinct Inventions I, claims 1-6 and Invention II, claims 7-22 are related as subcombinations disclosed as usable together in a single combination and that Invention II has separate utility such as an integrated circuit not using the planar transformer of Invention I. Such would appear to be completely impossible since the integrated circuit of Invention II as recited in claim 7 recites that the integrated circuit includes the very same substantially planar transformer of Invention I, claim 1. Thus, it would appear that the Examiner is making an allegation which is completely inaccurate, and unsupported by the specification and most particularly false the claims.

Thus, the invention as per Invention II of an integrated circuit including a substantially planar transformer does not have utility separate from the very same substantially planar transformer of Invention I. They both would be used in the same manner, namely transforming a frequency signal.

Therefore, Applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement and examine the application based on claims 1-23.

In any event, the Examiner is required to examine the elected invention, claims 1-6 and Species I along with the linking claim 23 and should the linking claim 23 be allowed further examination must immediately be performed with respect to the non-elected invention, claims 7-22, Species 2-6.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (1076.40768X00).

Respectfully submitted,

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